

## REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated August 14, 2003. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

### Status of the Claims

Claims 2-32 are under consideration in this application. Claim 1 is being cancelled without prejudice or disclaimer. Claims 2-5, 9, 17-26, and 28-32 are being amended, as set forth above in the marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim Applicants' invention.

### Additional Amendments

The claims are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

### Prior Art Rejection

Claims 1, 4, 5, 8, 17-19, 26-29, 31 and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,514,081 to Mengoli (hereinafter "Mengoli"). Claims 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mengoli, claims 3, 7, 9, 11-13, 15, 16 and 30 were rejected as being unpatentable over Mengoli in view of U.S. Pat. No. 6,183,259 to Macri et al. (hereinafter "Macri"), and claims 2, 6, 10 and 14 were rejected as unpatentable over Macri in view of U.S. Pat. No. 6,152,856 to Studor et al. (hereinafter "Studor"). These rejections have been carefully considered, but are most respectfully traversed.

The instructional method for a sport, a hobby, an amusement game or a daily activity according to the invention, as now recited in claim 30, comprises: displaying a main heading section of a plurality of basic examples of problem points (e.g., I in Fig. 2); displaying a concrete

subheading section (e.g., II in Fig. 2) as clicked by a learner on one of the basic examples of problem points; displaying a question form on demand ("by clicking the so-called (HELP) button" p. 11, last line) and analyzing entries by the learner addressed to the question form so as to determine a concrete problem of the learner; providing an electronic means for recording, editing and searching one improved performance image of an instructor corresponding the clicked or determined concrete problem point; and displaying said improved performance image of an instructor. The electronic means displays the main heading section, the subheading section, a performance image corresponding to the clicked or determined concrete problem point, the improved performance image of an instructor, the clicked or determined concrete problem point, and at least one method for overcoming the clicked or determined concrete problem point, and said method is presented in at least one of diagrammatic representation, letters, and speech sound. The clicked or determined concrete problem point is a concrete problem of the learner in *actually practicing* said sport, hobby, an amusement game or a daily activity ("individual problem point" page 5, lines 5-6; "his/her problem point" page 10, 3<sup>rd</sup> paragraph; "the learners themselves are not aware of their own problem points and they cannot comprehend where the problem is with their form." page 11, last paragraph).

The invention is also directed to a system (claim 31) or a software (claim 32) executing the method recited in claim 30.

The concrete problem of the learner in actually practicing is determined by (1) the learner's direct judgement ("it is thought that..." page 10, line 11; "learner can choose the form that most closely approximates the form thereto and by comparing and contrasting their own form and the instructor's form..." page 15, line 22) via directly clicking the problem on the screen; or (2) the self-diagnosis analysis guided/assisted by the electronic means via a question form ("Welcome to the golf swing analysis and lesson system" Fig. 5; p. 11, last paragraph to p. 12, 3<sup>rd</sup> paragraph), when "the learners themselves are not aware of their own problem points and they cannot comprehend where the problem is with their form." For example, if "the learner is worried about his driver swing, "driver" is clicked and, as for basic knowledge about driving, 'What kind of club is the driver?', etc., and as for missed shots, 'What is the tendency of your driver errors?', are displayed in letters. In the case where a plurality of error tendencies are confirmed, errors are to be viewed in order starting from higher error frequency items (p. 12, 4<sup>th</sup> paragraph)."

Applicants respectfully contend that neither Mengoli nor any other cited prior art reference, teaches or suggests an instructional method which "displays a question form on demand and analyzing entries by the learner addressed to the question form so as to determine a concrete problem of the learner" as the invention.

As admitted by the Examiner (p. 6, paragraph no. 18), Mengoli does not disclose a system or method of instruction for a sport improvement activity wherein a question form is displayed and entries are analyzed to determine a concrete problem of the learner.

The textual cues of Macri was replied upon by the Examiner to make the question form of the invention appear to be obvious. However, Applicants contend that Macri's cues are prompted "*to facilitate user trial, error and improvement* (col. 2, lines 53-54)" or "*to decrease distractions and improves comprehension* (col. 3, lines 41-42)" in simulation, e.g., to assist the player to designate the actions or images to be executed in the simulation (col. 10, line 11; e.g., "Now Perform a Right Crossover" in Figs. 16-17), rather than to guide/assist a learner to self-diagnose actual practice problems. Moreover, each of Macri's visual, audio, textual and tactile **cues/short phrases** may be just one independent cue/short phrase stating a fact, e.g., "Crossover equals 90%" in Fig. 12, rather than **a question form** having a series of related questions guiding/assisting the learner to determine a concrete problem. The problem-diagnosis aiding step of the invention is different in essence from Macri's "*observing an instructive (or ideal) way of doing something, receiving information and visual, audio, textual and tactile cues* (col. 2, lines 42-44)" in simulation.

One skilled in the art will not be motivated to combine Macri's cues with Mengoli in the manner suggested by the Examiner, since Mengoli concerns **actual practice** problems of a learner, while Macri's cues (col., lines 64-67; col. 10, lines 1-10) concerns what a player (even an handicapped person in Fig. 25) **wishes** to see in the **simulation**.

Studor fails to compensate for Macri's deficiencies. Studor merely varies the resistance setting of indoor exercise equipment (Fig. 1) in order to simulate varying degrees of difficulty. Studor has nothing to do with any actual practice of sports, etc. or any problems of the user in actually practicing such sports.

Although the invention applies the guiding/assisting mechanism of a question form, the invention applies the mechanism to an instructional method for a learner of a sport, a hobby, an amusement game or a daily activity to achieve unexpected results or properties. For example,

- analyzing *actual practice* problems of the learner by guiding/assisting a learner to self-diagnose actual practice problems via a question form. The presence of these unexpected properties is evidence of nonobviousness. MPEP§716.02(a).

*"Presence of a property not possessed by the prior art is evidence of nonobviousness.*

*In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing "'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' ").*

The unexpected properties were unknown and non-inherent functions in the prior art, since the prior art does not inherently achieve the same results. In other words, these advantages would not flow naturally from following the teachings of the prior art, since the prior art fails to suggest applying a question form by guiding/assisting the learner to self-diagnose actual practice problems of a sport, a hobby, an amusement game or a daily activity.

Applicants further contend that the mere fact that one of skill in the art could rearrange a prior art question form to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for one skilled in the art to provide the unexpected properties, such as applying a question form by guiding/assisting the learner to self-diagnose actual practice problems of a sport, a hobby, an amusement game or a daily activity, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)*. MPEP§2144.04 VI C.

Accordingly, the present invention as now recited in the independent claims 30, 31 and 32 is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicant respectfully contends that the prior art references cannot anticipate

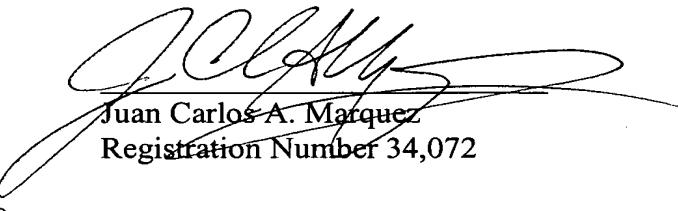
the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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